



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/601,453	06/23/2003	Yoshihiro Yazawa	1116-03	9728
35811	7590	10/11/2005	EXAMINER	
IP GROUP OF DLA PIPER RUDNICK GRAY CARY US LLP 1650 MARKET ST SUITE 4900 PHILADELPHIA, PA 19103			LAVILLA, MICHAEL E	
			ART UNIT	PAPER NUMBER
			1775	

DATE MAILED: 10/11/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/601,453

Applicant(s)

YOSHIHIRO, YAZAWA

Examiner

Michael La Villa

Art Unit

1775

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 August 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 June 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 20031119.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: The word "about" is misspelled several times in Claim 7. Appropriate correction is required.

Specification

2. The amendment filed on 13 August 2003 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: Applicant's various amendments set forth in the Preliminary Amendment filed on 13 August 2003 are not described as having antecedent support. While applicant asserts that no new matter is introduced by virtue of these amendments, it is unclear why this is the case. No reasons are given for permitting the changes, and reasons are not otherwise apparent.
3. Applicant is required to cancel the new matter in the reply to this Office Action.

Priority

4. Acknowledgment is made of applicant's claim for foreign priority based on an application filed in Japan on 6 September 2002. It is noted, however, that applicant has not filed a certified copy of the application, Japan 2002-

261773 09/06/2002, as required by 35 U.S.C. 119(b). While applicant has filed a document corresponding to this application, the front page having the certifying ribbon is not evident, and so the document is unacceptable as a filed certified copy of the application.

Claim Rejections - 35 USC § 112

5. The following is a quotation of the second paragraph of 35 U.S.C. 112:
6. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.
7. Claims 1-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
 - I. Regarding Claims 1 and 17, it is unclear what constitutes a "gap portion." Is this a spacing filled with air, a discontinuity in a surface, a surface region formed by a seam or weld, or something else? Is the gap to be in the structure, the FeCr substrate, or either?
 - II. Regarding Claims 3 and 19, it is unclear what is meant by the phrase "primarily contains." Does this requirement specify a percentage amount, or does it merely mean "contains"?

Claim Rejections - 35 USC § 102

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:
9. A person shall be entitled to a patent unless –

Art Unit: 1775

10. (a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.
11. (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.
12. Claims 1, 2, 5, 17, 18, and 21 are rejected under 35 U.S.C. 102(a and e) as being anticipated by Sakamoto et al. WO 02/099154. Sakamoto teaches seam welding a stainless steel sheet having a paint layer as claimed. See translation of Sakamoto in USPA 2003/0196715 (Abstract; paragraphs 39, 40, 6872, 80-86; and Table 3).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:
 - i. A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.
14. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:
 15. Determining the scope and contents of the prior art.
 16. Ascertaining the differences between the prior art and the claims at issue.
 17. Resolving the level of ordinary skill in the pertinent art.

Art Unit: 1775

18. Considering objective evidence present in the application indicating obviousness or nonobviousness.
19. Claims 4 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sakamoto et al. WO 02/099154. Sakamoto teaches seam welding a stainless steel sheet having a paint layer as claimed. See translation of Sakamoto in USPA 2003/0196715 (Abstract; paragraphs 39, 40, 6872, 80-86; and Table 3). Sakamoto may not exemplify the range of Cr contents in the steel of Sakamoto, but does suggest a wide range comparable to the claimed range. It would have been obvious to one of ordinary skill in the art at the time of the invention to fabricate the laminates of Sakamoto with steels having any of the suggested amounts of Cr as these are described as effective. It would have been obvious to one of ordinary skill in the art at the time of the invention to vary the amount of zinc powder within the suggested effective range. As such, the claimed amounts of zinc of Claim 4, for example, would be expected to be satisfied. For example, Sakamoto teaches varying the zinc amount close to 70 weight percent, which for any of the steels would satisfy the claimed range of zinc powder.

Allowable Subject Matter

20. Claims 3, 6-16, 19, and 22-28 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, 2nd paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

Art Unit: 1775

21. None of the reviewed prior art nor prior art of record teaches or suggests the subject matter of Claims 3, 6-16, 19, and 22-28. Particularly, articles containing and methods for making the claimed epoxy and the claimed steel substrate materials are not taught or suggested.


Conclusion

22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael La Villa whose telephone number is (571) 272-1539. The examiner can normally be reached on Monday through Friday.
23. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on (571) 272-1535. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 1775

24. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Michael La Villa
2 October 2005


MICHAEL E. LAVILLA PH.D.
PRIMARY EXAMINER